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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Hans-Georg Baumgarten

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EXAMINER

REPKO, JASON MICHAEL

ART UNIT

PAPER NUMBER

2628

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,487

Applicant(s)

BAUMGARTEN ET AL.

Examiner

Jason M. Repko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24,25,27 and 31 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 24,25,27 and 31 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

-) Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 24, 25, 27, and 31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

3. Claims 24, 25, 27, and 31 appear to be directed to an abstract idea rather than a practical application of the idea. The claimed invention does not result in a physical transformation nor does the claimed invention appear to provide a useful, concrete and tangible result. Claims 24, 25, 27, and 31 are directed to a process that does nothing more than solve a mathematical problem and manipulate abstract ideas.

4. Annex 5 of the "Interim Guidelines for Examination of Patent Application for Patent Subject Matter Eligibility" provides guidance with respect to the determination of the patentability of mathematical algorithms. If the "acts" of a claimed process manipulate only numbers, abstract concepts or ideas, or signals representing any of the foregoing, the acts are not being applied to appropriate subject matter. Benson, 409 U.S. at 71-72, 175 USPQ at 676. Thus, a process consisting solely of mathematical operations, i.e., converting one set of number into another set of numbers does not manipulate appropriate subject matter and thus cannot constitute a statutory process.

5. Claims 24, 25, 27, and 31 are directed to a process consisting solely of operations manipulating a set of mathematical entities. The result of the operations is set numbers representing intensity values arranged as a two-dimensional array. It fails to use the result of

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generating a modified digital image to enable its functionality to be realized. Additionally, the asserted practical application in the specification of generating a modified digital image is displaying a modified digital image. The practical application is not recited in the claims nor does it flow inherently therefrom. Therefore, claims 24, 25, 27, and 31 are directed to non-statutory subject matter.

6. To expedite a complete examination of the instant application, the claims rejected under 35 U.S.C. 101 as non-statutory subject matter are further rejected as set forth below in anticipation of applicant amending the claims to place them within the four categories of invention.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. **Claims 24, 25, 27 and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Takao Shimada, Naoko Iwami, Takewo Tomokane, Mitsuo Hayashi, Yasuyuki Kuwahara, “Interactive Scaling Control Mechanism For World-Wide Web Systems,” September 1997, The Sixth International Conference On World Wide Web, p. 1467-1477 (Shimada et al).**

9. With regard to claim 31, Shimada et al discloses “a method of accessing pre-stored modified images by a computer, comprising:

a. determining an index from at least one parameter of a process, selected from a plurality of processes that at least one of transform and convert an original digital image

differently, the at least one parameter determining how the original digital image is to be modified to form a modified digital image (3rd paragraph of section 3.1.1: “The command extension is written as “_ce(method, parameter)” where the method and parameter indicate the scaling method and its parameter at MSS.”);

b. determining an address of the modified digital image by reference to the index, if the modified digital image is included in the pre-stored modified images (3rd paragraph of section 3.1.1: “For example, “http://www.../care_ce(zoom,0.5).gif” is the virtual address of the object scaled down to one-half length along each dimension by MSS”);

c. accessing the modified digital image, if the address of the modified digital image can be determined with reference to the index (See Figure 3 showing accessing modified digital images ;section 4.2.3: “...in method (a), downloading time of the selected image is shorter than the others because the browser has cached the original images...”); and

d. generating and storing the modified digital image from the original digital image according to the process, if the modified digital image is not included in the pre-stored modified images (3rd paragraph of section 3.3.1: “MSS detects VURL in the request sent by browsers and extracts scaling information and stores it so that MSS will scale down the object according to the information. Scaling information is not only used for media scaling, but also for other VSCM processing.”).

10. With regard to claim 24, Shimada et al discloses “the modified digital image is accessed if the at least one parameter corresponds, within a predefined tolerance, to at least one stored parameter of the modified digital image” (3rd paragraph of section 3.3.1: “MSS detects VURL in the request sent by browsers and extracts scaling information and stores it so that MSS will scale

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down the object according to the information. Scaling information is not only used for media scaling, but also for other VSCM processing.”). One of ordinary skill in the art would recognize that the MSS inherently discloses a predefined zero tolerance, as the requested information is returned according to the parameters provided.

11. With regard to claim 25, Shimada et al discloses “the modified digital image includes information.” This feature is deemed inherent to the modified digital image disclosed by Shimada, as Figure 1 shows an image of object, which comprises information about the imaged object.

12. With regard to claim 27, Shimada et al discloses “the at least one parameter is a specific variable for influencing image data of the original digital image” (*3rd paragraph of section 3.1.1: “For example, “http://www.../care_ce(zoom,0.5).gif” is the virtual address of the object scaled down to one-half length along each dimension by MSS”; 3rd paragraph of section 3.3.1: “MSS detects VURL in the request sent by browsers and extracts scaling information and stores it so that MSS will scale down the object according to the information.”).*

Additional Remarks

13. As discussed in the Interview with Applicant’s representative on 6 December 2006. The claims would be in condition for allowance if claim 24 were amended to further limit the feature of a predefined tolerance to exclude a zero tolerance, incorporate claim 24 in independent claim 31, and further amended to place them within the four categories of invention. As previously shown, the predefined zero tolerance is inherent to the method disclosed by Shimada et al. However, the prior art of record does not disclose a non-zero predefined tolerance.

Response to Arguments

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14. Applicant's arguments filed 7/24/2006 with respect to the rejection(s) of claim(s) 24, 25, 27 and 31 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Takao Shimada, Naoko Iwami, Takewo Tomokane, Mitsuo Hayashi, Yasuyuki Kuwahara, "Interactive Scaling Control Mechanism for World-Wide Web Systems," September 1997, The Sixth International Conference On World Wide Web, p. 1467-1477.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. S. Kawashima, M. Tabata, Y. Kanamori, Y. Masunaga, "Versioning Model Of Image Objects For Easy Development Of Image Database Applications," 1996, Proceedings of the 7th International Workshop on Database and Expert Systems Applications, p.194-199 and M. Aritsugi, M. Tabata, H. Fukatsu, Y. Kanamori, Y. Funyu, "Manipulation of Image Objects and Their Versions Under CORBA Environment," Sept. 1997, Proceedings of the Eighth International Workshop on Database and Expert Systems Applications, p. 86-91 disclose transforming and storing images using an index based on the parameters of the transformation. Japanese Patent No. 04147386 A discloses providing an address corresponding to a density conversion parameter. U.S. Patent No. 4,790,025 to Inoue et al discloses transforming an image and an address according to transform parameters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Repko whose telephone number is 571-272-8624. The examiner can normally be reached on Monday through Friday 8:30 am -5:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMR


ULKA CHAUHAN
SUPERVISORY PATENT EXAMINER